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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,664	09/12/2000	Adam G. Southam	1399.001US1	6127

21186 7590 07/29/2004

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/659,664

Applicant(s)

SOUTHAM ET AL.

Examiner

Donald L. Champagne

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*ML*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed with an amendment on 9 April 2004 have been fully considered but they are not persuasive. The arguments are addressed at para. 7-8 below.

### *Claim Objections*

2. Claims 54-55 and 59-60 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims add only nonfunctional descriptive matter. See MPEP 2106.IV.B.1(b), first paragraph, and para. 7 below.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-60 are rejected under 35 U.S.C. 103(a) as being obvious over Logan et al.
5. Logan et al. teaches (independent claims 1, 30, 51 and 56) a system and method for exposing users to advertisements, the method comprising: obtaining a user specific set of data, *user data 143*, prior to distributing a media package (col. 5 lines 9-19); selecting a number of advertisements from a data bank **135** containing a plurality of advertisements based on the user specific set of data (col. 4 lines 15-27, col. 24 line 1 to col. 25 line 31, and col. 9 lines 41-57); and combining the selected number of advertisements with a requested set of media content to form a media package (*download compilation file 145*), and distributing the media package (col. 5 lines 19-36 and col. 15 lines 35-41).

6. In general, content and agreements are nonfunctional descriptive material (MPEP 2106.IV.B.1(b), first paragraph). "Syndicated content" and "information representative of syndication broadcast agreements" were accordingly not given patentable weight. To be given patentable weight, a limitation must limit some *technological* function of the claimed invention. The application provides no evidence that "syndicated" content or broadcast agreements have any technological function.
7. As noted below (para. 19), the disclosure is rich in technical detail, but that is of no help for giving patentable weight to the terms "syndicated content" and "information representative of syndication broadcast agreements" because these terms are not tied to this detail in any functional way with a "clear definition". Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111).
8. A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". In the instant case, the examiner is required to give the terms their broadest reasonable interpretation, which the examiner judges to be content and agreements functionally no different from any other content and agreements.
9. Logan et al. does not teach maintaining a database of agreements. Because it is impossible to run a business of any significant size without agreements with customers (*subscribers* in the reference), suppliers, distributors, etc., it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add maintaining a database of agreements to the teachings of Logan et al.
10. Logan et al. does not teach that the selection of ads is based on syndication broadcast agreements, which is interpreted as common agreements with suppliers setting limits on use and fees for ads. Because a business can be successful only by honoring its agreements, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Logan et al. that the selection of ads is based on syndication broadcast agreements.

11. Logan et al. also teaches (independent claims 9 and 39) an Internet user (col. 1 line 52) and localized data with geographically appropriate advertisements based on the obtained localized data (col. 9 lines 27-29), which, when inherently applied to the Internet, reads on with an appropriate geographic group of advertisements.
12. Logan et al. also teaches (independent claims 19 and 45) that the requested set of media content includes media content which has been previously distributed (col. 13 lines 45-55).
13. Logan et al. also teaches at the citations given above claims 2-3, 14, 31-34, 37, 52-55 and 57-60. Logan et al. also teaches claims 7 (col. 13 lines 3-20), 8 (col. 10 lines 3-4), 12 (col. 6 lines 48-51, col. 25 lines 4-14), 13, 17-18 and 40 (col. 25 lines 26-31 and col. 9 lines 41-57), 21 (col. 8 line 66), 24 and 43 (col. 14 lines 43-44), 35 (col. 29 lines 63 to col. 30 line 7) and 36 (col. 6 lines 48-51).
14. Logan et al. does not teach (independent claims 25, 47 and 48, and dependent claims 4-5, 15-16, 23, 26, 28, 42, 46 and 49) a network including a regional broadcast station and syndicated media content. Because Logan et al. teaches (col. 1 lines 13-15 and 39-43) that broadcast stations have the *wide variety of programming/large number of diverse programs* desirable for the reference invention's library, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a network including a regional broadcast station and syndicated media content to the teachings of Logan et al.
15. Logan et al. does not teach (claims 22, 27, 41 and 50) that the ads are regional or national. Because broadcast stations are obvious sources of programming (para. 14 above), and typically broadcast regional or national ads, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add both regional and national ads to the teachings of Logan et al.
16. Logan et al. does not teach (claim 6) displaying ads as frames. Because this is the most common means for displaying ads on the Internet, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the display of ads as frames to the teachings of Logan et al.
17. Logan et al. does not teach (claims 10, 29 and 44) a global positioning system. Logan et al. does teach a mobile receiver (col. 6 lines 18-32). Because GPS permits more precise geographic targeting of ads and provides the user with other benefits, it would have been

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obvious to one of ordinary skill in the art, at the time of the invention, to add GPS to the teachings of Logan et al.

18. Logan et al. does not teach (claims 11, 20 and 38) acquiring user data from an ISP or driver's license databases. Because both a readily available sources of good user characterization data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the acquisition of user data from an ISP or driver's license databases to the teachings of Logan et al.

### ***Possibility of Allowable Subject Matter***

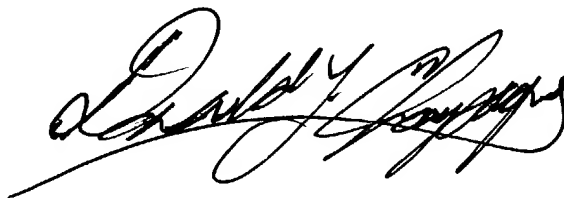
19. The claims and the background and summary of the specification (spec. p. 1-3 inclusive) suggest that the instant invention is Logan et al. as used by a regional broadcast station having rights to syndicated content. This does not patentably distinguish the instant claims from the prior art. However, the detailed description of the invention (spec. p. 4 et seq.) is rich in technical detail, some of which might make the instant application patentable.
20. For applicant's information, Brennan et al. (US006665517B2) has been made of record as an example of a US patent teaching a syndication invention.
21. Applicant is cautioned that an allowance would be dependent on the successful search of any new amendment.

### ***Conclusion***

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
25. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
26. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration. Applicant may have after final arguments considered and amendments entered by filing an RCE.
27. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne  
Primary Examiner  
Art Unit 3622

22 July 2004